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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,681	10/05/2006	Nicole Eggers	PAT-01236	2779

26922 7590 06/16/2008

BASF CORPORATION  
Patent Department  
1609 BIDDLE AVENUE  
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WYANDOTTE, MI 48192

EXAMINER
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FRANK, NOAH S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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06/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/599,681	<b>Applicant(s)</b> EGGERS ET AL.	
	<b>Examiner</b> NOAH FRANK	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hellmann et al. (US 2003/0105230).

Considering Claims 1, 6, 9-10: Hellmann et al. teaches a modular system comprising: A) at least one base module containing at least one binder, optionally together with organic solvents and B) at least one adhesion module containing at least one adhesion-promoting component, optionally together with conventional coating additives, water and/or organic solvents, and E) at least one crosslinking agent module containing at least one crosslinking agent, optionally together with organic solvents (¶0008-14). Component A preferably comprises hydroxyl-functional binders (¶0025). Component B comprises chlorinated polyolefins (¶0045). Component E comprises polyisocyanates (¶0060).

Considering Claims 2-3: Hellmann et al. teaches the solids content of solutions of chlorinated polyolefins being 18-60 wt-% (¶0045).

Considering Claims 4-5: Hellmann et al. teaches the chlorinated polyolefins having a degree of chlorination of 15-45 wt-% (¶0045).

Considering Claim 7: Hellmann et al. teaches additives being leveling agents, anti-foaming agents, catalysts, dispersing agents, thickeners, and emulsifiers (§§0039).

Considering Claim 8: Hellmann et al. teaches the organic solvents being mono- or polyhydric alcohols and esters (§§0039), both of which are isocyanate-reactive.

Considering Claim 11: Hellmann et al. teaches the modular system further comprising components C) and D) (§§0011-12).

Considering Claim 12: Hellmann et al. teaches producing coating compositions by mixing together the individual modules which are stored as finished units (§§0074).

Considering Claim 13: Hellmann et al. teaches coating substrates with the coating composition (§§0075).

Considering Claim 14: Hellmann et al. teaches producing coating compositions by mixing together the individual modules which are stored as finished units (§§0074).

Considering Claim 15: Hellmann et al. teaches the ratio of reactive functional groups of the binders to the complementarily reactive functional groups of the crosslinking agents being 1:2-2:1 (§§0065).

Considering Claim 16: Hellmann et al. teaches module B containing 15% of a 40% chlorinated polyolefin mixture (§§0080). Module B is then mixed with 1:1 module A, followed by a 4:1 ratio of (A + B):E (§§0086). 15% deionised water is then added to the mixture, resulting in a final chlorinated olefin content of 2.04%.

Considering Claim 17: Hellmann et al. teaches the production of coating compositions with good adhesion (§§0007).

Considering Claim 18: Hellmann et al. teaches coating polycarbonate (§§0091).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hellmann et al. (US 2003/0105230), as applied to claims 1-18 above, and further in view of Merritt et al. (US 6,939,916).

Considering Claims 19-20: Hellmann et al. teaches the basic claimed method as set forth above.

Hellman does not teach the system having a film thickness of up to 10  $\mu\text{m}$ . However, Merritt et al. teaches adhesion promoter coatings based on chlorinated polyolefins (Abs), applied at thicknesses from about 0.01 to about 5.0 mils (0.254-127  $\mu\text{m}$ ) (14:25-30). Hellmann and Merritt are combinable because they are from the same field of endeavor, namely chlorinated polyolefin coatings. At the time of the invention a person of ordinary skill in the art would have found it obvious to have used the thicknesses, as taught by Merritt, in the invention of Hellmann, in order to make an adhesion promoting coating.

### ***Response to Arguments***

Applicant's arguments filed 2/29/08 have been fully considered but they are not persuasive.

In response to applicant's argument that module B) of Hellmann contains binders, Hellmann states that such binders are 'optional' (Abs), or 'may' be present (§0046). Therefore, it is by no means a necessary part of Hellmann's invention, and anticipates a "component free from biners" (instant claim 1).

In response to applicant's arguments that module A) of Hellmann is not free from chlorinated polyolefins, the preferred module A) comprises hydroxyl-functional poly(meth)acrylates (§0037), which do not contain chlorinated polyolefins.

In response to applicant's arguments that Hellmann does not teach all of the claimed elements "arranged as in the claim", claim 1 uses the transitional phrase 'comprising', which is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. MPEP 2111.02

In response to applicant's arguments regarding organic solvents, Hellmann clearly teaches using an organic solvent in both module A (§0040) and B (§0044).

In response to applicant's arguments regarding the component comprising at least one polyisocyanate, Hellmann teaches that compounds with isocyanate groups are preferably used in accordance with the preferred functionality of the binders used in module A (§0059).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH FRANK whose telephone number is (571)270-3667. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NF  
6-9-08

/David Wu/

Supervisory Patent Examiner, Art Unit 1796